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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,133	05/06/2004	Albrecht Weiss	5005.1078	7239
23280	7590	09/16/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			EXAMINER NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/840,133

Applicant(s)

WEISS ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/6/04 &amp; 9/30/04</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The drawings contained three sheets of figures 1-4 were received on 5/6/2004. These drawings are approved by the Examiner.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities: The brief descriptions of figures 3 and 4 as provided in sections [0016]-[0017] are confusing with respect to the detailed descriptions provided in sections [0020] and [0026]. In particular, while section [0016] states that the figure 3 shows a microscope having an arrangement for compensating the image offset produced by an analyzer; however, in section [0020], it is noted that figure 3 shows a microscope having a fluorescent device. In the same viewpoint, while section [0017] states that the figure 4 shows a microscope having a fluorescent device; however, in section [0026], it is noted that the figure 4 shows a microscope having an arrangement for compensating the image offset produced by an analyzer. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification has not provided support for the arrangement of the analyzer and the wedge plates inside a common mount as recited in claim 4. Applicant is respectfully invited to review the specification, in particular, section [0018], in which the specification discloses that the wedge plates are arranged inside a receiving ring (4).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 9 is indefinite because the claim is dependent upon itself.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiency thereof.

***Claim Objections***

8. Claims 1 and 8 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 1: on line 8, "plate" should be changed to --plates-- (see also claim 2, line 2; claim 3, line 2, etc...).

b) In claim 8: on line 9, "plate" should be changed to --plates--. It is also suggested that the terms thereof --the steps of-- should be added after "comprising" appeared on line 1.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-11, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Takabayashi et al (EP 510 329, submitted by applicant) in view of Aono (Japanese reference No. 2001-91822).

Takabayashi et al disclose an optical system. The system as described in columns 8-11 and shown in figure 4 comprises the following features: First, an interference contrast transmitted-light device (C2) having an analyzer (39) which is able to insert into the imaging light path wherein the analyzer inherently causes a beam deflection; Second, a fluorescent device (C1); Third, the interference contrast transmitted-light device and the fluorescent device is selectably and alternatively inserted into the imaging light path via a mechanism (47-48); Fourth, a receiving system having a CCD for receiving images provided by the interference contrast transmitted-light device and the fluorescent device; Fifth, a control system having a CPU (51), a memory (50), ...for processing the images. See columns 10-11. Regarding to the feature that the analyzer is a polarizing

film, such a feature is inherent from the structure of the analyzer because the analyzer is inherently a combination of a polarizing film formed on a substrate. The only feature missing from the system provided by Takabayashi et al is that they do not state the use of a compensating element after the analyzer for the purpose of cancellation the beam deflection of the analyzer.

The use of a compensating element after an analyzer for the purpose of compensating for the change in optical path length caused by the changes in fluorescent cubes is known to one skilled in the art as can be seen in the microscope having fluorescent device and interference contrast transmitted-light device provided by Aono. In particular, in columns 11+ and figure 7, Aono disclose a compensating element (43) in the form of two wedged-plates (43a and 43b) of the same configuration wherein the compensating element is disposed after the analyzer (25). While Aono does not clearly state that the movement of one of the wedged-shaped plates is compensated for the change in the beam deflection caused by the analyzer; however, such a result is obtained due to the movement of the at least one wedged-shaped plate of the compensating element. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the system as provided by Takabayashi et al by using a compensating element in the form of two wedged-shaped plates disposed after an analyzer as suggested by Aono for the purpose of compensating for the change in beam deflection caused by the analyzer.

Regarding to the method as recited in the present claim 8-11, it would have been obvious to one skilled in the art at the time the invention was made to set forth a set of steps which includes the step of receiving an image by using the interference contrast transmitted-light device (C2), the step of receiving an image by using the fluorescent cube (C1) via the mechanism (47-48), the step of combination the two images (see Takabayashi et al, columns 10-11), and then the step of utilizing a compensating element after the analyzer for the purpose of compensating the change in beam deflection caused by the analyzer.

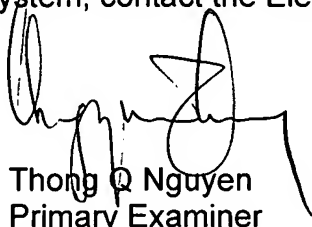
### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. It is noted that duplicate citations of the Germany reference 35 42 218 have been lined-through to prevent that reference from being printed twice on the face of the patent should this application pass to issue.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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